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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,391	02/02/2000	James D. San Antonio	SAN01-NP001	6140

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Clifford Kent Weber Esq  
Thomas Jefferson University  
Office of University Counsel  
1020 Walnut Street - Suite 620  
Philadelphia, PA 19107-5587

[REDACTED] EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/496,391

Applicant(s)

San Antonio et al

Examiner

Karen Canella

Art Unit

1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 1-75 are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9 and 64-69, drawn to synthetic peptides, classified in class 530, subclass 300.
  - II. Claims 16, 25, 34, 43 and 61, drawn to a method of affinity purification using the synthetic peptide of Group I, classified in class 530, subclass 413.
  - III. Claims 14, 23, 32, 41, 50 and 59, drawn to methods of targeting drugs comprising the administration of the peptides of Group I to a mammal, classified in class 514, subclass 2.
  - IV. Claims 12, 21, 30, 39, 48, and 57, drawn to methods for modulating tumor cell metastasis comprising the administration of the peptides of Group I, classified in class 514, subclass 2.
  - V. Claims 10, 11, 13, 15, 17-20, 22, 24, 26-29, 31, 33, 35-38, 40, 42, 44-47, 49, 51, 52-56, 58, 60, 62, 63 and 70-75, drawn to methods of modulating glycosaminoglycans with anti-coagulant activity, methods of modulating enzymes that act on glycosaminoglycans, methods of blocking tissue uptake and clearance of heparin, methods of promoting wound healing, methods of promoting cell attachment or adhesion and methods for modulating endothelial cell pro-coagulant or anti-coagulant functions, all methods comprising administering the peptide of Group I, classified in class 514, subclass 2.
2. The inventions are distinct, each from the other because of the following reasons:  
The methods of Groups II, III, IV and V differ in the method objectives, method steps and parameters and in the reagents used.

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Invention I is related to Inventions II, III, IV and V as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the peptides of Invention I can be used in any of the methods II-V. In addition, the peptides of Group I can be used in a process to raise an antibody and an anti-idiotypic antibody.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

3. With the election of any Group, a further election of the following peptide groups is required:

- a. XBBBXXBX,
- b. XBXXBBBX,
- c. XBBXBX, or
- d. XBXB BX.

Each structure comprises structurally and functionally diverse products. The examination of all structures would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues. Because these peptide groups are distinct for the reasons given above and because the searches required for the peptide groups are not co-extensive, restriction for examination purposes is considered proper.

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4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(j).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

October 19, 2002